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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,730	08/09/2005	William R Blackwood	DC5018 PCT 1	6040
137 7590 09/22/2009 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER				
OJURONGBE, OLATUNDE S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/22/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary

Application No.

10/517,730

Applicant(s)

BLACKWOOD ET AL.

Examiner

OLATUNDE S. OJURONGBE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on 07/02/2009 has been entered. Claims 1-8 and 10-17 are pending in the application.
2. In view of the amendment to the claims, the prior indication of allowable subject matter is withdrawn, and the following rejection is made. Note that this rejection is same which was made in Final Rejection of 10/30/08, and was considered proper before the amendment which was considered to be new matter. The new matter is now removed, hence the previous rejection is applied again.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. **Claims 1- 8 and 10-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Young et al (US 4,212,897)**.

Regarding **claims 1 and 13**, Young et al teaches a composition that includes (a) an organopolysiloxane containing hydroxyl groups, and (b) a hydrolyzable organic titanium compound or a partial hydrolyzate thereof (col.1, lines 62-68). Young et al further teaches that the organopolysiloxanes suitable for use in the invention contain the structural unit of col.2, lines 5-10, wherein the number of X radicals ranges from one radical per polysiloxane molecule up to 30 weight percent of the total organopolysiloxane molecular weight (col.2, lines 30-36). Young et al further teaches examples of the organopolysiloxanes (a) of the invention to include a predominantly monoorganopolysiloxane (col.2, lines 37-45), and further teaches that in order to be useful in the invention, the organopolysiloxane of the invention must be readily soluble or dispersible in organic solvents (col.2, lines 46-62). Young et al further teaches the composition of the invention including diluents (col.6, lines 14-26), and further

exemplifies the composition of the invention, prepared by combining 10g siloxane copolymer having $(\text{CH}_3)_3\text{SiO}$ and SiO_2 groups (3 wt% OH), 10g dimethylpolysiloxane fluid, and 10 g tetraisopropyl titanate (see Example XIII, col.16, lines 45-col.17, line 27). Young et al does not teach a composition or a method comprising (A) of the instant claim. Motivated by the desire to generate an organopolysiloxane with optimal solubility in organic solvent, it would have been obvious to one of ordinary skill in the art to have used various forms of the exemplified siloxane copolymer of Young et al, including those that are predominantly monoorganopolysiloxane. The examiner notes a considerable overlap in the range of copolymers encompassed by the predominantly monoorganopolysiloxane copolymer having $(\text{CH}_3)_3\text{SiO}$ and SiO_2 groups of Young et al, and the range of copolymers encompassed by component (A) of the instant claim.

Regarding **claims 2-3**, though Young et al does not explicitly teach the R on the monoorganopolysiloxane being methyl, since the taught R on the $(\text{CH}_3)_3\text{SiO}$ group of the siloxane copolymer of Young et al is methyl, motivated by compatibility reasons, it would have been obvious to one of ordinary skill in the art to have used methyl as the organic group of the predominantly monoorganopolysiloxane copolymer.

Regarding **claims 4-5**, the dimethylpolysiloxane of Young et al meets the limitations of the instant claim.

Regarding **claims 6-8**, the 10g of tetraisopropyl titanate of Young et al meets the limitations of the instant claim.

Regarding **claims 10-11,16 and 17**,Young et al further teaches the composition of the invention containing 30g perchloroethylene (co1.16, line 53).

Regarding **claim 12**,Young et al further teaches the composition of the invention containing 30g perchloroethylene (co1.16, line 53). Young et al does not teach the composition further comprising (D) of the instant claim. Motivated by the desire to generate a composition with optimal properties-which includes viscosity-it would have been obvious to one of ordinary skill in the art to have formed various versions of the composition of Young et al, including those that contain 40 to 200 parts by weight of perchloroethylene per 100 parts by weight of component (a).

Regarding **claims 14-15**, Young et al further teaches applying the composition of the invention to a large number of substrates, including wood (co1.6, lines 27-28 and co1.6, line 42).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796